

**PRE-APPEAL BRIEF REQUEST FOR  
REVIEW**

Docket Number 042933/271450

(filed with the Notice of Appeal)

Application Number 10/797,765

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First Named Inventor Poyhonen

Art Unit 2617

Examiner Gonzalez, Amancio

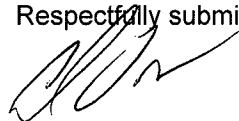
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

Respectfully submitted,



Andrew T. Spence  
Registration No. 45,699

Date March 17, 2011

**Customer No. 10949**

**ALSTON & BIRD LLP**

Bank of America Plaza

101 South Tryon Street, Suite 4000

Charlotte, NC 28280-4000

Tel Charlotte Office (704) 444-1000

Fax Charlotte Office (704) 444-1111

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## Attachment

### Reasons for Requesting Pre-Appeal Brief Request For Review

These remarks are hereby filed concurrent with a second Pre-Appeal Brief Request for Review. The Examiner continues to reject all of the pending claims under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Application Publication No. 2002/0064164 to Barany et al., or under 35 U.S.C. § 103(a) as being unpatentable over Barany, in view of either U.S. Patent Application Publication No. 2004/0156380 to Silverman et al., or U.S. Patent Application Publication No. 2005/0210292 to Adams et al. As explained below, Applicant respectfully submits that the claimed invention is patentably distinct from Barany, Silverman and Adams, taken individually or in any proper combination. In view of the remarks presented herein, Applicant respectfully requests reconsideration and withdrawal of all of the rejections.

#### ***A. Claims 1-4, 7-12, 14, 16-21, 23, 25-30, 32-39, 43-48 and 52-54 are Patentable***

The Examiner rejects Claims 1-4, 7-12, 14, 16-21, 23, 25-30, 32-39, 43-48 and 52-54 as being anticipated by Barany. Initially, Applicant notes that for a reference to anticipate a claim, “[t]he identical invention must be shown in as complete detail as is contained in the...claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989) (cited in MPEP § 2131). A single cited reference must expressly or inherently disclose each claim limitation. *Finstar Corp. v. DirectTV Group, Inc.*, 523 F.3d 1323, 1334 (Fed. Cir. 2003). “But disclosure of each element is not quite enough... ‘[a]nticipation requires the presence in a single prior art disclosure of all the elements of the claimed invention arranged as in the claim.’” *Id.* (quoting *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548) (emphasis added). Further, the Federal Circuit has reversed lower courts when those lower courts have “treated the claims as mere catalogs of separate parts, in disregard to the part-to-part relationships set forth in the claims that give the claims their meaning.” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1459 (Fed. Cir. 1984).

The following subsections present Applicant’s arguments for patentability, and address the Examiner’s responses to those arguments. The Examiner identifies Applicant’s arguments as raising issues, which the Examiner has numbered in the final Official Action and Applicant follows below.

#### ***1. Claims 1-9, 19-27 and 37-45 are Patentable over Barany***

Relative to independent Claim 1 (and similarly independent Claims 19 and 37), Applicant respectfully submits that Barany fails to teach or suggest several elements of the claims.

##### ***(a) Network-Independent Trigger - Issues (1)-(3)***

In contrast to independent Claim 1, Barany does not teach or suggest a network-independent trigger prepared for transmission to a terminal in response to receipt of a connection request. The Examiner cites the SIP INVITE of paragraph [0063] of Barany for this feature, but as identified as issue

(1) in the final Official Action, nowhere does Barany disclose that its SIP INVITE is prepared for transmission “in response to receipt of a connection request;” instead, Barany’s SIP INVITE is a connection request. *See* Barany, para. [0063] (“To initiate a call, the SIP INVITE request is sent ....”). Accordingly, as identified as issue (2), Barany also does not disclose that its SIP INVITE is independent of the network via which a connection request is received, i.e., “network-independent.” Moreover, per issue (3), Barany does not disclose that its SIP INVITE is prepared for transmission to the terminal from which a registration message is received. In Barany, the SIP INVITE is transmitted from the mobile station that registered with the CSCF.

In response to issue (1), the Examiner states that by virtue of Barany’s SIP proxy receiving a SIP INVITE (alleged connection request) and forwarding it to an intended destination, the forwarded SIP INVITE constitutes a trigger prepared for transmission in response to receipt of a connection request. In this interpretation, the Examiner appears to consider the SIP INVITE to constitute both the recited connection request and trigger, but even given this interpretation (and now turning to issue (2)), Barany still does not disclose that its SIP proxy receives the SIP INVITE (alleged connection request) via a network, but forwards the SIP INVITE (alleged trigger) independent of the network, similar to the trigger of independent Claim 1.

In response to issue (2), the Examiner states that “according to fig. 5 of the present application, the Examiner understands the network independent trigger as a communication initiation between the SIP proxy and the terminating node or client as the result of forwarding a requested call, which is clearly disclosed by Barany.” Official Action of Jan. 4, 2011, p. 3. Applicant notes that the network-independent trigger of FIG. 5 (non-IP trigger) is not the result of the SIP proxy forwarding a requested call, but is instead in response to the SIP proxy receiving an INVITE message. The SIP proxy does not forward the INVITE message to the terminating SIP client until later in the process after the terminating SIP client has registered with the SIP proxy.

Further, Applicant submits that the network-independent trigger is more than simply a communication between SIP proxy and terminating node or client. Rather, the network-independent trigger is a communication independent of the network via which the connection request is received, i.e., “network independent.” Applicant submits that any interpretation of the recited trigger that does not consider that the trigger is explicitly recited as being “network-independent” impermissibly fails to give all words in the claim their normal meaning. *See Ex parte Maurice Givens*, Appeal No. 2009-003414, Application No. 11/265,973 (BPAI Aug. 6, 2009) (holding that a claim interpretation that fails to give weight to words in a claim deprives the respective words of their normal meaning).

In response to issue (3), the Examiner states: “[I]f the SIP proxy receives call requests on behalf of other entities and forwards said call requests to intended destinations ..., it is evident that the response to the requested call replaces the SIP INVITE sent from the SIP proxy to the destination node or client and is prepared for transmission to the terminal from which a registration message is received.” Official

Action of Jan. 4, 2011, p. 3. Even if one could argue that the response to a SIP INVITE is prepared for transmission to the terminal having originally sent the SIP INVITE message, however, the response is not being cited as corresponding to the recited trigger. Instead, the Examiner cites the SIP INVITE message itself as the recited network independent trigger. And to now cite a response message as the trigger, the Examiner is impermissibly treating the claims as a mere catalog of separate parts, and disregards the part-to-part relationships set forth in the claims.

The SIP INVITE of Barany therefore does not correspond to the trigger of Claim 1.

**(b) Registration Message - Issue (4)**

As identified as issue (4), in further contrast to independent Claim 1, Barany does not teach or suggest receipt of a registration message, in response to the network-independent trigger, via the network to thereby register the terminal and acquire a network-dependent identity of the terminal. The Examiner cites the SIP registration procedure of paragraph [0062] of Barany for this feature. However, nowhere does Barany disclose that its SIP registration procedure occurs or that any registration message is received in response to the SIP INVITE – similar to the recited receipt of a registration message “in response to the network-independent trigger.” In fact, Barany explicitly discloses that SIP registration occurs before (not in response to) its SIP INVITE (alleged trigger) is sent. *See* Barany, para. [0063] (“After SIP registration, the mobile station can initiate a ... call .... To initiate a call, the SIP INVITE request is sent ....”).

In response to issue (4), the Examiner asserts that it is well known that registration has to take place to establish communication between telecommunication devices, and that Barany clearly discloses SIP registration. Applicant agrees that Barany discloses SIP registration, but instead of Barany disclosing receipt of a registration message in response to a SIP INVITE (alleged trigger), Barany discloses receipt of a registration message (or rather, SIP registration) before the SIP INVITE. According to independent Claim 1, on the other hand, the registration message is received in response to the trigger (alleged SIP INVITE), and not vice versa.

***2. Claims 10-18, 28-36 and 46-54 are Patentable over Barany***

As identified as issue (5), in contrast to independent Claim 10, Barany does not teach or suggest a network-independent trigger prepared for transmission to a terminal based upon a network-independent identity of the terminal to thereby trigger the terminal to update its registration with the apparatus, including acquisition by the apparatus of a network-dependent identity of the terminal to thereby enable establishment of a communication session with the terminal based upon the network-dependent identity of the terminal. The Examiner cites the SIP INVITE of paragraph [0063] of Barany for this feature, and for other features of independent Claim 10, cites GSM as the received network via which a registration message is received, and an IP address of a mobile station as the recited network-independent identity.

In contrast to the foregoing, and as identified as issue (6), nowhere does Barany disclose that the SIP INVITE is independent of the network (alleged GSM) via which the registration message is received, i.e., “network-independent.” Barany also does not disclose that its SIP INVITE is prepared for transmission to the terminal from which a registration message is received. In Barany, the SIP INVITE is transmitted from the mobile station that registered with the CSCF. Further, nowhere does Barany disclose that its SIP INVITE triggers the mobile station “to update registration” of the mobile station (alleged terminal) with the CSCF (alleged apparatus). Other than disclosing that the SIP INVITE is sent after SIP registration, nowhere does Barany disclose that its SIP INVITE has any affect on SIP registration. Moreover, nowhere does Barany disclose acquisition of a GSM-dependent identity (network-dependent identity, GSM being the alleged network) of the mobile station to enable establishment of a communication session with the mobile station based on the GSM-dependent identity (network-dependent identity), similar to independent Claim 10.

In response to issue (5), the Examiner states that “since the SIP proxy receives call requests on behalf of other entities and forwards said call requests to intended destinations (see [0023]), there is no way to communicate with an intended destination without an identity of the destination node or device.” Official Action of Jan. 4, 2011, p. 4. Applicant fails to see how the fact that communication with a destination requires its identity has any pertinence to whether Barany anticipates the claimed invention. As explained above, independent Claim 1 recites preparation of a network-independent trigger for transmission to a terminal based on a network-independent identity of the terminal, which triggers the terminal to update its registration including acquisition of a network-dependent identity of the terminal. Even if Barany does communicate with an intended destination based on its identity, nowhere does Barany disclose that its SIP INVITE (alleged trigger) is network-independent and prepared for transmission based on a network-independent identity. And further, nowhere does Barany disclose that its SIP INVITE triggers a registration update including acquisition of a network-dependent identity.

Regarding issue (6), the Examiner reiterates its interpretation of the network-independent trigger as in issue (2). But as explained above, not only is this interpretation incorrect, it fails to give all words in the claim their normal meaning. That is, the network-independent trigger is not the result of the SIP proxy forwarding a requested call, but is instead in response to the SIP proxy receiving an INVITE message. And any interpretation of the recited trigger that ignores the explicit recitation of the trigger being network-independent impermissibly fails to give all words in the claim their normal meaning, as required.

Applicant therefore respectfully submits that independent Claim 1, and by dependency Claims 2-9, is patentably distinct from Barany. Applicant also respectfully submit that independent Claims 10, 19, 28, 37 and 46 recite subject matter similar to that of independent Claim 1; and as such, Applicant also respectfully submits that independent Claims 10, 19, 28, 37 and 46, and by dependency Claims 11-18, 20-27, 29-36, 38-45 and 47-54, are patentably distinct from Barany.

***B. Claims 5, 6, 13, 15, 22, 24, 31, 33, 40, 42, 49 and 51 are Patentable***

The Examiner rejects Claims 5, 6, 13, 15, 22, 24, 31, 33, 40, 42, 49 and 51 as being unpatentable over Barany, in view of Silverman or Adams. As explained above, independent Claims 1, 10, 19, 28, 37 and 46, and by dependency Claims 2-9, 11-18, 20-27, 29-36, 38-45 and 47-54, are patentably distinct from Barany. Applicant respectfully submits that neither Silverman nor Adams cures the deficiencies of Barany, and there is no apparent reason for one skilled in the art still to modify Barany with the teachings of either Silverman or Adams in an effort to obviate the claimed invention. Thus, for at least the reasons given above, Claims 5, 6, 13, 15, 22, 24, 31, 33, 40, 42, 49 and 51 are also patentably distinct from Barany, in view of Silverman.

Respectfully submitted,



Andrew T. Spence  
Registration No. 45,699

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